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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,669	05/13/2002	H. Darrel Darby	A7705	6168
23373	7590	04/21/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,669	Applicant(s) DARBY, H. DARREL	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) 33, 34, 37, 39 and 40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 6, 9 and 12-30 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 35, 36, and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Restriction/Election

1. Claims 26-30 have been rejoined and examined due to the allowability of claim 25 from which these claims depend.

Claims 33 and 34 remain withdrawn as directed towards a nonelected invention. It is noted that these claims depend from claim 32 which is not patentable/allowable and therefore there is no inventive concept present.

Claims 37, 39, and 40 remain withdrawn as directed towards a nonelected invention. It is noted that these claims depend from claim 35 or claim 36 which is not patentable/allowable and therefore there is no inventive concept present.

Claim Rejections - 35 USC § 112

2. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31 the phrase "insole assembly adaptable for treating a weight bearing..." is functional, indefinite, and incomplete because it is not clear what structural limitations applicant intends to encompass with such language. There has been no recitation of any structure which would perform the recited function. There is no structure claimed which performs the function of the removability of an oval area.

In claim 32 the phrase "the oval area" lacks antecedent basis rendering the claim vague and indefinite. The preceding claim merely recites that the insole is adaptable for removing an oval area, no oval area has been positively recited.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 35, 36, and 38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Darby (5370133).

Darby shows a shoe comprising an outsole (16) with a circumferential counter (shown at 16A) and a fitting marker (front of element 32) and the outsole has a tapered toe (22C) and Heel (22B), and flat middle portion (22A) as claimed.

In reference to claim 38, Darby '133 shows an insole comprising an insole having a plurality of distinct layers (shown in figure 1) as claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3728

6. Claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby (5491909) in view of Darby (5370133) and Grim (5329705).

Darby '909 shows a shoe comprising an outsole (16), an upper (14), an insole assembly (18), and a shank (22) substantially as claimed except for the sole having a circumferential counter portion and the exact layered insole. Darby '133 teaches providing an outsole with a circumferential counter portion (shown as 16A in figure 1). Grim teaches providing an insole with a plurality of different layers and having a removable area (68) for use in a medical shoe. It would have been obvious to provide the outsole with a counter portion as taught by Darby '133 and to provide an insole having a plurality of layers as taught by Grim in the shoe of Darby '909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medical benefits of the insole construction taught by Grim.

7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 above, and further in view of Kellerman (5799414).

Darby '909 as modified above shows an insole assembly substantially as claimed except for skiving the edges of the oval area. Kellerman teaches skiving/chamfering the edges of an opening (see column 5 lines 27-46). It would have been obvious to skive/chamfer the edges of the opening as taught by Kellerman in the insole assembly of Darby '909 as modified above to provide a smooth transition and to make the removable portion easier to remove.

Allowable Subject Matter

8. Claims 3, 6, 9, and 12-30 are allowed.

Response to Arguments

9. Applicant's arguments filed 3/11/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the 112 rejection, it is noted that the claim language does not recite any structural limitation of a removed oval area or an area which is removable and therefore there is no structural limitations claimed which allow the functional language of the "adaptable" insole as claimed.

In response to applicants' arguments directed towards the counter preventing the insole layers from shifting, the circumferential counter of Darby '133 clearly and inherently would prevent the insole layers from shifting. It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971).

In response to applicants' arguments that the layers of Grim are not separately removable, this is not true, the use of hook and loop fasteners clearly noted as elements 72 and 54 allow at least three of the insole layers to be separately removable.

Priority

10. It is noted that the claim for priority to the provisional application is acknowledged, although it is not a requirement for the Examiner to acknowledge the claim for priority to provisional applications.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For

Art Unit: 3728

applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner _____ of Art Unit _____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728